

## **REMARKS**

Claims 1-17, 19, and 20 remain pending. Claims 1, 15, and 16 have been amended to merely clarify the invention.

The Examiner has rejected claims 15-17 under 35 U.S.C. §102(e) as being anticipated by Muller et al. (U.S. Patent No. 6,044,087). The Examiner has also rejected claims 1-10 and 19-20 under 35 U.S.C. §103(a) as being unpatentable over Muller et al. in view of Official Notice. Claims 11-12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Muller et al. in view of Lese et al. (4,761,800), and claims 13-14 are rejected as being unpatentable over Muller et al. in view of Chow et al. (6,169,742). The rejections are respectfully traversed for at least the following reasons.

Claim 1 is directed towards a “method of communicating between a media access control layer and a physical layer.” Claim 1 also requires “receiving a plurality of time-division multiplexed receive control signals on a single receive control pin” and “sending a plurality of time-division multiplexed transmit control signals on a single transmit control pin.” Claim 1 also requires “wherein the receive control signals include a receive data valid signal and a receive error signal time-division multiplexed together on the single receive control pin and the transmit control signals include a transmit enable signal and a transmit error signal time-division multiplexed together on the single transmit control pin.” Independent claim 15 is directed towards an “interface between a first media access control layer and a second media access control layer.” Claim 15 also requires “a time-division multiplexed receive control pin for receiving different functional types of receive control signals including a receive data valid signal and a receive error signal time-division multiplexed together on the receive control pin” and “a time-division multiplexed transmit control pin for transmitting different functional types of transmit control signals including a transmit enable signal and a transmit error signal time-division multiplexed together on the transmit control pin.” Independent claim 16 has similar elements. In other words, mechanisms are provided for receiving the receive data valid signal on the same single pin as the receive error signal and for transmitting the transmit enable signal on the same single pin as the transmit error signal.

Although the primary reference Muller et al. teaches multiplexing of certain signals onto a same pin, Muller et al. does not specifically teach that the transmit enable signal is transmitted on the same pin as the transmit error signal. Likewise, Muller et al. fails to specifically teach that the receive data valid signal is received onto the same pin as the receive error signal. In contrast, Muller shows that these signals are transmitted or received on separate pins. Muller teaches that the set of signals TxD0, TxD1, and TxD3 are multiplexed with the set of signals

TXD3, TXEN, and TXER so that the first set transmits during the first half of the clock cycle, while the second set transmits during the second half of the clock cycle. See Fig. 3b. However, the signals from each set are individually transmitted on three separate output pins 309. See Fig. 3a. Likewise, the set of signals RxD0, RxD1, RxD3 are received during the first half of the clock and the set of signals are RxD3, RxDv, and RxER are received during the second half of the clock cycle. Fig. 4b. However, the signals from each set are individually received onto three separate output pins (unlabeled). See Fig. 4a. Furthermore, Muller et al. lists the signals which are multiplexed as being Tx\_D0 with Tx\_D3; Tx\_D1 with Tx\_EN (transmit enable); Tx\_D2 with Tx\_ER (transmit error); Rx\_D0 with Rx\_D3; Rx\_D1 with Rx\_DV (receive data valid); and Rx\_D2 with Rx\_ER (receive error). See Col. 6, Lines 33-42. In other words, although the transmit enable Tx\_EN is multiplexed with data bit Tx\_D1, it is not multiplexed with the transmit error Tx\_ER. Likewise, although the receive data valid Rx\_DV is multiplexed with data bit Rx\_D1, it is not multiplexed with the receive error Rx\_ER, in the manner claimed. The secondary references also fail to teach such multiplexing of signals in the manner claimed.

#### Response to Examiner's Arguments

The Examiner argues that the passage in the Muller et al. reference in Col. 6, Lines 33-41 anticipates a receive data valid signal being multiplexed with a receive error signal and a transmit enable signal multiplexed with a transmit error signal. This passage of Muller states generally that "signals can be multiplexed in a variety of ways" and then describes a specific multiplexing scheme which differs from the claimed invention's multiplexing scheme.

It is respectfully argued that the inventive multiplexing scheme of the present invention is not enabled in the Muller et al. reference. The only passage of Muller et al. which can be argued to encompass the claimed multiplexing invention is the single statement "signals can be multiplexed in a variety of ways." Throughout the specification, Muller fails to teach anything at all regarding how such a specific inventive multiplexing scheme would be implemented. Muller fails to show any diagrams illustrating the time of such a specific inventive multiplexing scheme and fails to describe anything regarding how such a specific inventive multiplexing scheme would function. Since Muller et al. fails to enable the specific claimed inventive multiplexing scheme, it is respectfully submitted that 1, 15, and 16 are patentable over the cited reference.

Even if the cited passage "signals can be multiplexed in a variety of ways" were considered enabling for the specific claimed multiplexing scheme, this statement would only be considered, at most, a genus of the inventive multiplexing species. It is submitted that a prior art reference which merely recites a genus which encompasses a claimed inventive species cannot be used to establish a *prima facie* obvious rejection against such inventive species. MPEP §2144.08 states that "the fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness. *In re Baird*, 16

F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) ("The fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious."). Although this type of argument of patentability is typically used for chemical subject matter, it is submitted that the "section 103 requirement of unobviousness is no different in chemical cases than with respect to other categories of patentable inventions." *In re Papesch*, 315 F.2d 381, 385, 137 USPQ 43, 47 (CCPA 1963). Thus, the principal that "a claimed inventive species that is encompassed in a prior art genus cannot establish a prima facie case of obviousness" is applicable to inventions other than chemical compounds, e.g., inventive multiplexing schemes. Since Muller et al. can only arguably be considered to teach a genus of the claimed invention (as well as a species that is not the same as the inventive multiplexing scheme), a prima facie case of obviousness cannot be established against claims 1, 15, and 16 with the cited reference.

The Examiner's rejections of the dependent claims are also respectfully traversed. However, to expedite prosecution, all of these claims will not be argued separately. Claims 2-14, 17, and 19-20 depend directly or indirectly from independent claims 1 or 16 and, therefore, are respectfully submitted to be patentable over cited art for at least the reasons set forth above with respect to claims 1 or 16. Further, the dependent claims require additional elements that when considered in context of the claimed inventions further patentably distinguish the invention from the cited art.

Applicant believes that all pending claims are allowable and respectfully requests a Notice of Allowance for this application from the Examiner. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Respectfully submitted,  
BEYER WEAVER & THOMAS, LLP



Mary Ramos Olynick  
Reg. 42,963

P.O. Box 778  
Berkeley, CA 94704-0778  
(510) 843-6200